



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John D. Hottovy

Serial No.: 10/699,151

Filed: October 31, 2003

For: METHOD AND APPARATUS
FOR REDUCING REACTOR
FINES

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Commissioner for Patents
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Group Art Unit: 1723

Examiner: Cheung, William K.

Atty. Docket: CPCM:0020/FLE/RAR
210330US00

CERTIFICATE OF MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

June 15, 2006
Date

Betty Broyles
Betty Broyles

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In light of the following remarks, Appellants respectfully request review of the Final Rejection in the above-identified application. This Request is being filed with a Notice of Appeal. No amendments are being filed with this Request.

In the non-final Office Action, the Examiner rejected claims 1-11 and 17-22 under U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Stanley et al. (U.S. Patent No. 3,244,681). In the Final Office Action, the Examiner withdrew the § 102(b) portion of the rejection. Appellants stress that *the finality of the rejection is improper and should be withdrawn* because the Examiner has not addressed the subject matter of independent claim 7 (which is radically different than the subject matter of claim 1).

To establish *prima facie* obviousness of a claimed invention, the Examiner must show that all the claim limitations are taught or are suggested by the prior art. *In re Royka*,

490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); M.P.E.P. § 2144.03. Here, the Examiner did *not* specifically address independent claim 7. At the very least, an explanation of the rejection of independent claim 7 is required for at least the reasons that the record be made clear and that Appellants have a fair opportunity to respond. *See* 37 C.F.R. § 1.104.

Independent Claim 1

Turning to the claims, the present independent claim 1 recites “polymerizing in a loop reactor . . . at least one olefin monomer . . . *wherein said inner surface of said loop reactor has a root mean square surface roughness less than about 120 micro inches.*” (Emphasis added). In the non-final Office Action, the Examiner contended that the Stanley reference suggests use of “a loop reactor having a reactor zone (inner surfaces) with [sic] smooth surface, or a smooth as possible.” Office Action, page 5. The Examiner stated that he “has a reasonable basis to believe that the claimed smoothness properties are *inherently* possessed in Stanley et al.” *Id.* (emphasis added). The Examiner concluded that since “the PTO does not have proper means to conduct experiments, the *burden of proof* is now shifted to Appellants to show otherwise.” Office Action page 5 (emphasis added) (citing *In re Best*, 195 USPQ 430 (C.C.P.A. 1977) and *In re Fitzgerald*, 205 U.S.P.Q. 594 (C.C.P.A. 1980)). However, the Stanley reference does not disclose a loop reactor having “a root mean square surface roughness less than about 120 micro inches,” as claimed.

In addressing this deficiency of the Stanley reference, the Examiner relied upon the principle of inherency to establish that all of the missing elements are present in the Stanley reference. Such reliance on inherency is misplaced. In establishing inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d at 743. Here, while the Stanley reference mentions “a tubular closed loop reaction zone having smooth surfaces,” the

Examiner has not shown that the Stanley surfaces necessarily possess a root mean square surface roughness less than about 120 micro inches. See Stanley, col. 1, lines 60-65. The Examiner falls short of meeting his evidentiary burden.

Furthermore, Appellants stress that the Examiner's reference to the *In re Best* and *In re Fitzgerald* cases is misplaced. See Office Action, page 5 (citing *In re Best*, 195 U.S.P.Q. at 430 and *In re Fitzgerald*, 205 U.S.P.Q. at 594). The reasoning in these two cases with regard to the evidentiary burden of the PTO is directed to product-by-process type claims where it is difficult for the PTO to show that a unique process provides claimed physical characteristics. See, e.g., *In re Best*, 195 U.S.P.Q. at 432-33. In contrast, here, Appellants do *not* require a unique method to provide the presently claimed roughness values of the inner surface of the loop reactor. In addition, the roughness of a surface having the claimed roughness values is readily measurable.

Independent Claim 7

Independent claim 7 recites "a first polymerization step . . . to produce . . . solid olefin polymer particles having a melt index less than 0.3 gm/10 min; and a second polymerization step . . . to produce . . . solid olefin polymer particles having a melt index greater than 0.4 gm/10 min." Initially, Appellants emphasize that the Stanley reference does not teach or suggest these recited features. Further, as mentioned, the Examiner did *not* address the subject matter of independent claim 7. Therefore, Appellants respectfully request that the Examiner address the specific subject matter of claim 7 or withdraw the rejection of claim 7 and its dependent claims. Appellants remind the Examiner that "[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner *must* provide clear explanations by all actions taken by the examiner during prosecution of an application." M.P.E.P. § 707.07(d) (emphasis added).

Moreover, Appellants emphasize that the Examiner *must* address the subject matter of independent claim 7 to reject claim 7 under Section 103. Indeed, to establish *prima facie* obviousness of a claimed invention, the Examiner must show that all the claim limitations are taught or are suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); M.P.E.P. § 2144.03. Here, the Examiner did *not* specifically address independent claim 7. Accordingly, Appellants again traverse these unsupported rejections of independent claim 7.

Independent Claims 1 and 7

In addition, with regard to both independent claims 1 and 7, the Examiner failed to provide a difference, a modification, and an explanation which would support an obviousness rejection and which might be responded to by Appellants. “It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply.” M.P.E.P., §706.02(j). In this instance, Appellants are unfairly prejudiced by not being provided what the Examiner considers to be the distinction between the reference and the claims, the proposed modification, and the presumed suggestion or motivation to make the modification as provided by the reference. The failure of the Examiner to provide the noted information precludes a *prima facie* case of obviousness from being established.

Such a *prima facie* case must demonstrate some suggestion or motivation to modify the reference, a reasonable expectation of success, and that all the claim elements are taught or suggested by the prior art reference. M.P.E.P., §706.02(j). Appellants respectfully submit that the Examiner did not establish these required components of a *prima facie* case based on the Stanley reference. As discussed, the Stanley reference fails to teach or suggest all the elements of the instant claims. Further, there is no suggestion or motivation within the Stanley reference to modify the disclosed configuration to correspond to the recitations in the present claims. Likewise, considering the silence of

considering the silence of the Stanley reference as to any suggestion to modify the disclosed configuration, the Stanley reference is also silent as to the likelihood of success of any such modification.

Accordingly, Appellants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 103 and to allow pending claims 1-11 and 17-22.

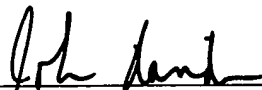
Conclusion

Appellants respectfully submit that all pending claims should be in condition for allowance. However, as indicated, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date:

June 15, 2006



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